

Remarks

Claims 1-20 are pending in the above-identified application. Claims 1 is amended, claim 7 is cancelled, and claims 2-6, and 8-20 are original.

The Examiner rejected claims 1-2, 4-5, and 9 under 35 U.S.C. 102(e) as being anticipated by McCarthy US 2003/0167230; rejected claims 3, 6 and 8 under 35 U.S.C. 103(a) as being unpatentable over McCarthy and further in view of Kim KR2001-110374; and rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over McCarthy and further in view of Staack US 2004/0078439.

With this amendment of the claims, claim 1 has been amended to include all the limitations of original claim 7, and claim 7 has been cancelled. Therefore, with the amendment of claim 1 the rejection of the claims under 35 U.S.C. 102(e) is deemed moot. The rejection of the claims under 35 U.S.C. 103(a) will be discussed based on the rejection of original claim 7 under 35 U.S.C. 103(a).

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 provides: The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

One court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Id. at 1357, 47 USPQ2d at 1458. Here, according to this court, the Board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.

The Examiner has alleged that McCarthy teaches a method for providing network support for an attribute feature for customization of mobile terminals by a telecommunication network (title, abstract) the method comprising the steps of: storing in the telecommunication network at least one attribute for use by at least one mobile terminal (abstract teaches content available in the network for download to mobile device. Also see figure 3.); sending at least one attribute request from the mobile terminal to the telecommunication network (figure 3 shows step of

wireless terminal requesting download from WAP portal thru to Content Provider, steps #60-61); recognizing, by the telecommunication network, the attribute request from the mobile terminal (figure 3 shows steps #61-67 whereby network validates user account and item to be downloaded); downloading, by the telecommunication network, the requested attribute to the mobile terminal (figure 3 shows steps #67-#70 whereby item is fetched and downloaded); and installing the attribute in the mobile terminal (figure 3, step 73 shows item being saved/stored on mobile device. Also see figures 4-6 and Para's 0003-0007 which teach downloading/storing ring tunes, tactile feedback, graphic icon, animation, background, etc.).

The Examiner cited Kim as teaching a method for downloading a font to a cellular phone so that a user can easily change the existing font.

The Examiner has admitted that McCarthy does not teach: storing in a subscriber database a data entry indicative of the mobile terminal being a subscriber of the attribute feature; and checking, upon receiving an attribute request, the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network.

The Examiner then alleges that Staack teaches that the HLR stores user profile/attribute information because a user database contains user related information such as subscription information and configuration information. The Examiner states that: "The examiner interprets the user related information such as subscription information and configuration information as storing the phone's attributes as well."

The Examiner then concludes that it would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it stores in a subscriber database a data entry indicative of the mobile terminal being a subscriber of the attribute feature and checks upon

receiving an attribute request, the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network, to provide means for only allowing the user to download items/attributes they don't have stored on their phone.

McCarthy discloses a content subject to payment that is downloadable from a content provider to a wireless terminal via a communication network. A software application in the wireless terminal is opened, the downloadable content is requested from the open software application. The terminal automatically starts up a network session, and transmits a request for downloading the downloadable content for the software application. When the content provider replies to the request by sending the content, the wireless terminal receives the content for the software application for pre-study (pre-view, listening, feeling etc). Payment for the downloadable content for the software application for enabling storing of the downloadable content for the software application is handled, whereby storing of the downloadable content for the software application from which the downloadable content becomes possible.

Kim discloses a method for downloading font data for a cellular phone is provided so that a user can easily change a font of the cellular phone, by searching the font data to be downloaded through a personal computer communication, Internet, voice response system or cellular phone terminal, and selecting a wanted font from the font data.

Staack discloses a messaging method for use in a communications system comprises the steps of sending a message from a system user, the message being intended for a first set of recipients, defining a second set of recipients to which the message is to be sent if it is determined that the message is not to be received by at least one of the recipients of the first set, the first and second set being different and sending a request to prevent delivery of the message

to said at least one recipient not to receive the message if it is determined that the message is not to be received by at least one recipient of the first set, and delivering the message only to the recipients of the second set.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Prima facie obviousness only exist when the prior art suggests or anticipates the benefits of modifying or combining references or when external factors, such as the changing state of the art, provide the motivation to one of ordinary skill in the art to make the modification or combination. However, where no reasonable intrinsic or extrinsic justification exists for the proposed combination or modification, prima facie obviousness will not have been established. In the present case not only is there no justification for combining the references, but the Examiner has even had to make an assumption that the user related information such as subscription information and configuration information also refers to the phone's attributes. There is no basis for such an assumption.

The black letter law statements by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) are applicable to the present rejections, viz:

a) Hindsight Syndrome

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. ... Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." (Id. at 1369, 55 USPQ2d at 1316) (citations omitted).

b) Need for Motivation

Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. *See Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (Id. at 1369, 55 USPQ2d at 1316) (citations omitted).

c) Particular Findings Required

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ... Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusionary statements standing alone are not "evidence." (Id. at 1370, 55 USPQ2d 1317) (citations omitted).

For example, it is only with hindsight of Applicant's invention that the Examiner would make an assumption that the user related information such as subscription information and configuration information also refers to the phone's attributes.

Therefore, independent claim 1 is patentable over McCarthy and in view of Staack as well as in view of Kim. Also, the dependent claims 2-6 and 8-9, since they include all the limitations of the independent claims upon which they depend are also patentable over any combination of the cited prior art.

The Examiner rejected claims 10-20 under 35 U.S.C. 103(a) as being unpatentable over McCarthy and further in view of Kim and Staack. The Examiners argument are the same as those

that were set forth with regards to the rejection of claims 1-10. Therefore, Applicant believes that claims 10-20 are patentable over McCarthy and further in view of Kim and Staack for the reasons set forth above with regards to the rejection of claims 10-20.

More specifically, independent claim 10 and 16 are patentable over any combination of the cited prior art for the reasons set forth above with respect to independent claim 1. Claims 11-15 and 17-20 are dependent claims that include all the limitations of the respective independent claims upon which they depend, and are therefore also allowable over the cited prior art for the reasons set forth above with respect to independent claim 1.

The prima facie case of obviousness determination has not been made out. Thus, the opinion of obviousness is deficient and the Applicants are deserving of a patent.

Applicants respectfully submit that the applied references, taken singly or in combination, assuming, arguendo, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Reconsideration and withdrawal of the rejections is therefore respectfully requested. In view of the above remarks, allowance of all claims pending is respectfully requested.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicant's attorney.

Respectfully submitted,



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